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PATENT

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December 7, 2005

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Anita J. Galo

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Anita J. Galo

NAME OF PERSON SIGNING

12/7/2005

DATE OF SIGNATURE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Martin Wany et al.
Serial No. : 10/533,682
Filed : 27 April 2005
Int'l Appln. No. : PCT/CH03/00704
Int'l Filing Date : 28 October 2003
Priority Date : 29 October 2002
For : OPTOELECTRONIC SENSOR
Attorney Docket No. : HU-7638

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §1.47(a) TO FILE
APPLICATION WITH INVENTOR WHO REFUSES TO SIGN**

Dear Sir:

This petition requests the examination of the above-identified patent application.

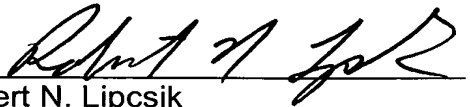
In accordance with M.P.E.P. §409.03(d), this petition includes a declaration of the facts surrounding the conduct of the applicant, which conduct constitutes a

Best Available Copy

refusal to execute the above-identified patent application by the inventor, Martin

Waeny.

Date: December 7, 2005


Robert N. Lipcsik
Reg. No. 44,460

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO L.L.P.
526 Superior Avenue, Suite 1111
Cleveland, Ohio 44114-1400
Phone: (216) 621-2234
Fax: (216) 621-4072
Customer No. 26, 294

Declaration

concerning the Facts relating to the refusal of Mr. Wäny to sign the application papers of U.S. Patent Application No. 10/533,682, corresponding to PCT International Application PCT/CH2003/000704

I, Peter Mario Schwider, do hereby solemnly declare:

I am the CTO of Photonfocus AG, Lachen, Switzerland, and co-inventor of the above-mentioned Patent Application. I have first-hand knowledge of the circumstances of the refusal of Mr. Wäny to sign the application papers of the above-mentioned U.S. Patent Application.

PCT International Application PCT/CH2003/000704 was filed on October 28, 2003. At that time, Mr. Wäny was employed with Photonfocus AG. Mr. Wäny had participated actively in the preparations for the filing of said application. At the time, there was no dispute whatsoever over the fact that the right in the patent application was owned by Photonfocus AG.

Mr. Wäny remained to be employed with Photonfocus AG until April 30, 2004. Already around the time when Mr. Wäny left Photonfocus AG, he was unsuccessfully requested orally several times to sign the application papers of PCT application PCT/CH2003/000704.

With letter of May 5, 2004, Mr. Wäny was asked to appear in person on the premises of Photonfocus AG for signing the application papers of PCT application PCT/CH2003/000704. This letter is enclosed as exhibit B1, a translation thereof as exhibit B2. The letter was sent by registered mail, but was returned by the Swiss Postal Service with the remarks "nicht abgeholt" and "verschollen" ("not collected", "residence unknown"). A copy of the envelope of the returned letter is enclosed as exhibit B3.

On December 29, 2004, a letter was received from Mr. Wäny in which he communicated an address change and requested that any future communications be sent to his new address in Funchal (Portugal). This letter is enclosed as exhibit B4, a translation thereof as exhibit B5. The address communicated therein reads:

Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
Appt CT
9000-246 Funchal
Portugal

This is Mr. Wäny's last known address.

A letter relating to an earlier PCT application PCT/EP01/11673, published as WO 03/032394, was sent to Mr. Wäny's new address on February 18, 2005, and is enclosed as exhibit B6. No response was received. For more background information in this connection, reference is made to the Petition filed October 25, 2004 and to the Renewed Petition filed July 29, 2005 and granted on September 20, 2005 for earlier application No. 10/491,999 which derived from PCT application PCT/EP01/11673, published as WO 03/032394.

Subsequently, the above-referenced U.S. application was filed in the United States Patent and Trademark Office on April 27, 2005.

On November 5, 2005, I sent a letter to Mr. Wäny at his last known address in Funchal, requesting him to sign the application papers of this U.S. application and enclosing a copy thereof (specification, claims and drawings of the German-language PCT application as well as of the translation of these items filed in the USPTO; declaration and power of attorney; assignment). This letter is enclosed as exhibit B7. A letter with identical wording, enclosed as exhibit B8, was sent to the address of the German establishment of his new employer, AWAIBA Lda., in Ahrens Dorf (Germany). Both letters were sent by registered mail with return receipt.

The letter sent to Mr. Wäny's home address in Funchal was delivered on November 11, 2005, but was returned unopened. A copy of the unopened envelope bearing the postmark of Funchal is enclosed as exhibit B9.

The letter sent to Mr. Wäny via AWAIBA Lda. in Ahrens Dorf was, according to the return receipt enclosed as exhibit B10, delivered on November 11, 2005. No response was received to this letter.

On the evening of November 7, 2005, I met Mr. Wäny in person in Stuttgart, Germany. On that occasion, I confronted him once more with the application papers to be signed, including the declaration and power of attorney, an assignment form and the specification, claims and drawings of the German-language PCT application as well as the translation of these items filed in the USPTO. Mr. Wäny expressly refused to sign the application papers.

I met Mr. Wäny once more on November 10, 2005 at the booth of Photonfocus AG at the trade fair "Vision 2005", which took place in Stuttgart, Germany, from November 8 to 11, 2005. Once more, Mr. Wäny expressly refused to sign the application papers. As a witness, Mr. Bruno Reihl, CEO and member of the board of Photonfocus AG, was present at that meeting.

Lachen, *24. 11. 2005*

Peter Mario Schwider
.....

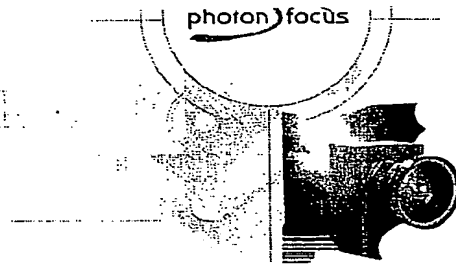
Peter Mario Schwider

Enclosures
Exhibits B1 to B10

PHOTONFOCUS AG
Bahnhofplatz 10
CH-8853 Lachen SZ

Tel. +41 (0)55 451 00 00
Fax +41 (0)55 451 00 01

info@photonfocus.com
www.photonfocus.com



B1

EINSCHREIBEN
Herr Martin Wäny
Dorfstrasse 4
8834 Schindellegi

Lachen, den 5. Mai 2004

Unterschriften

Lieber Martin

Da Du weder zum vereinbarten Termin vom 30.04.2004 erschienen bist, noch auf unserem eingeschriebenen Brief reagiert hast, melde ich mich nochmals schriftlich bei Dir. Zur Erinnerung Dein Arbeitsvertrag lief bis zum 31. April 2004.

Ich beziehe mich auf Dein Schreiben vom 27.04.2004, in dem Du mich bittest die Anmeldeschrift der Patentanmeldung PCT/CH03/00704 Dir zu zustellen. Ich mache Dich aufmerksam auf den Grundsatz Ziff. 11 und Art. 332 Abs. 1 OR, der aus auch explizit aus dem Arbeitsvertrag hervorgeht:

„Erfindungen, die der Arbeitnehmer bei Ausübung seiner dienstlichen Tätigkeiten und in Erfüllung seiner werkvertraglichen Pflicht macht, oder an deren Hervorbringung er mitwirkt, gehören unabhängig von ihrer Schutzfähigkeit dem Arbeitgeber.“

Ich bitte Dich daher Dich sofort bei uns zu melden, um einen Termin festzulegen, damit Du die Unterlagen bei uns Vorort unterschreiben kannst.

Für Dein Verständnis bedanke ich mich im Voraus und grüsse Dich freundlich

Photonfocus AG

Mangold René

REGISTERED MAIL

Mr. Martin Wäny
Dorfstr. 4
8834 Schindellegi

B2

Lachen, May 5, 2004

Signatures

Dear Martin

Since you have neither appeared at the appointment of April 30, 2004 as agreed, nor reacted to our registered letter, I contact you once again in written form. As a reminder, your work contract was in force until April 30, 2004.

I refer to your letter of April 27, 2004, in which you ask to have the specification of patent application PCT/CH03/00704 sent to you. I call the principle No. 11 and Art. 332 (1) OR to your attention, which also follows explicitly from your work contract:

"Inventions which are made by the employee while exercising his official employment activities and in fulfilment of his contractual duties, or to whose creation he contributes, belong to the employer independent of their patentability."

I therefore ask you to contact us immediately in order to make an appointment such that you can sign the papers on our premises.

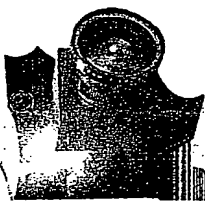
I thank you for your understanding and send you my regards

Photonfocus AG

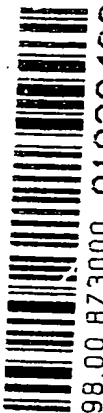
Mangold René

photon focus

Photonfocus AG
Bahnhofplatz 10
CH-8853 Lachen SZ
Switzerland
www.photonfocus.com
info@photonfocus.com



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Lettre Signature (LSI)

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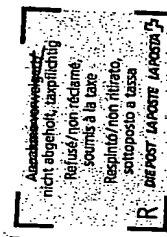


LSI

Lettre Signature

EINSCHREIBEN
Herr Martin Wäny
Dorfstrasse 4
8834 Schindellegi

verschoben
TD



Handwritten signature

B3

B4

Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
Appt CT
9000-246 Funchal
Madeira / Portugal

Funchal 29.12.2004

Einschreiben

Herrn Robert Grüter
Verwaltungsratspräsident Photonfocus AG
Hofhalde 18
6403 Küssnacht am Rigi/SZ
Switzerland

Adressänderung

Sehr geehrte Herren

Ich bitte Sie folgende Mutation im Aktienbuch der Photonfocus AG vorzunehmen:

Bisherige Adresse:

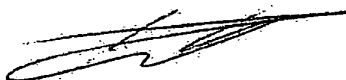
Martin Wäny
Dorfstrasse 4
8834 Schindellegi
Schweiz

Neu, ab sofort:

Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
Appt CT
9000-246 Funchal
Madeira / Portugal

Ich bitte Sie ausserdem sämtliche Korrespondenz an die neue Adresse zu senden.

Mit Freundlichen Grüssen



Martin Wäny

B5

Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
Appt CT
9000-246 Funchal
Madeira/Portugal

Funchal, December 29, 2004

REGISTERED MAIL
Mr. Robert Grüter
President of the Board Photonfocus AG
Hofhalde 18
6403 Küssnacht am Rigi/SZ
Schweiz

Address change

Dear Sirs

I ask you to have the following change recorded in the share register of Photonfocus AG:

Previous address:

Martin Wäny
Dorfstrasse 4
8834 Schindellegi
Schweiz

New, with immediate effect:

Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
Appt CT
9000-246 Funchal
Madeira/Portugal

I further ask you to send all correspondence to the new address.

Yours sincerely

Martin Wäny

B6

Photonfocus AG
Board of Directors
Bahnhofplatz 10
CH-8853 Lachen
Switzerland

18.2.2005

To
Martin Wany
Trv. Dos Piornais
Edf. Famoso Bloco F
9000-246 Funchal
Portugal

Via registered mail

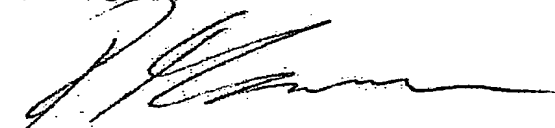
Dear Martin,

after numerous previous attempts by phone and by mail (for example by mail dated May 5, 2004) we presently again try to contact you in order to be able to fulfill the formal requirements before the USPTO in relation to the application WO 03/032394.

As you are well aware, you are obliged in view of Article 332 of the Swiss code of obligations to sign these documents, since any invention you made in the course of your employment contract dated 22.05.01 belongs to the employer, i.e. Photonfocus AG, and this is even expressly stipulated in paragraph 11 of this employment contract.

Since the application was filed on October 9, 2001 which is after the signing date of your employment contract and before you left the company in 2004, it is beyond doubt that you made the invention, which is clearly in the technical field of the employer and which was made since you were employed in the research and development for this technical field, such that it clearly belongs to the employer. You are therefore urged again to sign the two documents attached, which are named "assignment of patent application" and "combined declaration and power of attorney", and to return them to us as quickly as possible. For your complete information, please also find enclosed a copy of the specification of the application to make sure that you know exactly which application the documents refer to. Please return the signed documents via express 1-day mail.

Best Regards



René Mangold

CEO Photonfocus AG



Dr. Peter Mario Schwider

CTO Photonfocus AG

Enclosures:

Specification of WO 03/032394

Assignment of patent application (to be signed)

Combined declaration and power of attorney (to be signed)

Photonfocus AG
Board of Directors
Bahnhofplatz 10
CH-8853 Lachen
Switzerland

05.11.2005

B7

To
Martin Wäny
Trv. Dos Piornais
Edf. Famoso Bloco F
9000-246 Funchal
Portugal

Via registered mail

Dear Martin,

after numerous previous attempts by phone and by mail (for example by mail dated May 5, 2004 and 18.2.2005) we presently again try to contact you in order to be able to fulfil the formal requirements before the USPTO in relation to the application WO 2004/040904 A1 (PCT/CH2003/000704).

As you are well aware, you are obliged in view of Article 332 of the Swiss code of obligations to sign these documents, since any invention you made in the course of your employment contract dated 22.05.01 belongs to the employer, i.e. Photonfocus, and this is even expressly stipulated in paragraph 11 of this employment contract.

Since the application was filed on October 28, 2003 which is after the signing date of your employment contract and before you left the company in 2004, it is beyond doubt that you made the invention, which is clearly in the technical field of the employer and which was made since you were employed in the research and development for this technical field, such that it clearly belongs to the employer. You are therefore urged again to sign the two documents attached, which are named "assignment of patent application" and "combined declaration and power of attorney", and to return them to us as quickly as possible. For your complete information, please also find enclosed a copy of the specification of the application to make sure that you know exactly which application the documents refer to.

Best Regards



Dr. Peter Mario Schwider

CTO Photonfocus

Enclosures:

Specification of 2004/040904 A1 and USA text
Assignment of patent application (to be signed)
Combined declaration and power of attorney (to be signed)

Photonfocus AG
Board of Directors
Bahnhofplatz 10
CH-8853 Lachen
Switzerland

05.11.2005

B8

To
Martin Wäny
Dörpstele 20
D-22927 Grosshansdorf
Germany

Via registered mail

after numerous previous attempts by phone and by mail (for example by mail dated May 5, 2004 and 18.2.2005) we presently again try to contact you in order to be able to fulfil the formal requirements before the USPTO in relation to the application WO 2004/040904 A1 (PCT/CH2003/000704).

As you are well aware, you are obliged in view of Article 332 of the Swiss code of obligations to sign these documents, since any invention you made in the course of your employment contract dated 22.05.01 belongs to the employer, i.e. Photonfocus, and this is even expressly stipulated in paragraph 11 of this employment contract.

Since the application was filed on October 28, 2003 which is after the signing date of your employment contract and before you left the company in 2004, it is beyond doubt that you made the invention, which is clearly in the technical field of the employer and which was made since you were employed in the research and development for this technical field, such that it clearly belongs to the employer. You are therefore urged again to sign the two documents attached, which are named "assignment of patent application" and "combined declaration and power of attorney", and to return them to us as quickly as possible. For your complete information, please also find enclosed a copy of the specification of the application to make sure that you know exactly which application the documents refer to.

Best Regards



Dr. Peter Mario Schwider

CTO Photonfocus

Enclosures:

Specification of 2004/040904 A1 and USA text
Assignment of patent application (to be signed)
Combined declaration and power of attorney (to be signed)

photon focus

Bahnhofplatz 10 | CH-8853 Lachen SZ | Switzerland

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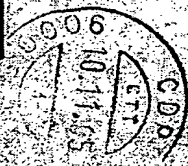
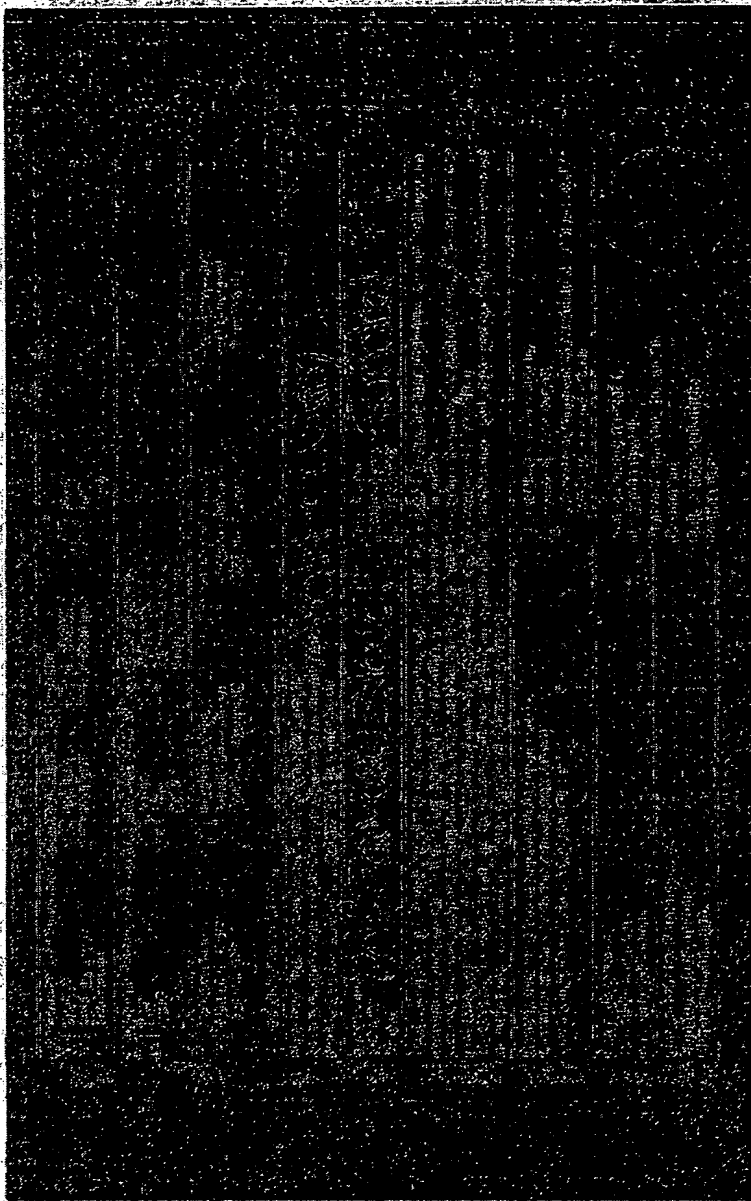
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Martin Wang
Fro. Dos Rionnais
Ed. Famoso Bloco F N-1
9000-246 Funchal
Portugal 35

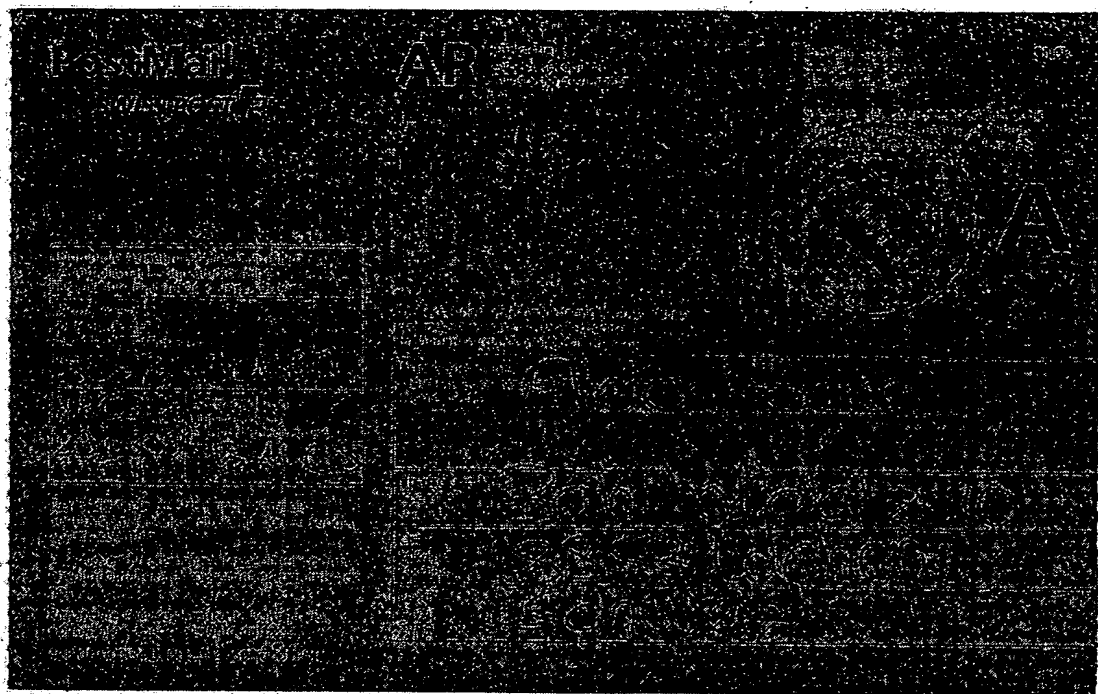
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photon focus

Bahnhofplatz 10
CH-8853 Lachen SZ



B10





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